

Application No. 10/656,134
Response to Office Action dated January 27, 2009

REMARKS

Claims 31-34, 36-37, 39-53, 55 and 57-62 are active with method claims 57-61 withdrawn.

Claim 62 is amended to correct the typographical error such that it now depends on Claim 31.

Claims 31 and 47 have been amended to define the one specific compound from the listing provided in previously presented, but now cancelled, Claim 38.

No new matter is added.

In the pending Official Action, the Examiner has withdrawn the previous obviousness rejection but now has raised a rejection alleging that the claims are not properly described in the specification citing 35 USC 112, first paragraph.

In short, the Examiner has taken the view that only the specific examples are adequately described. Therefore, if Applicants limit the claims to the structuring agent and the film former in the examples, then the rejection would be withdrawn (see page 5 of the Official Action).

While Applicants appreciate the Examiner's suggestion, Applicants respectfully do not agree with the assertions applied under the 112, first paragraph rejection.

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The purpose of the written description requirement is to ensure that a patent application conveys to a person of skill in the art that the applicants had possession of the claimed invention. See, e.g., LizardTech, Inc. v. Earth Resource Mapping, Inc., 424 F3d 1336, 1345, 76 USPQ2d 1724, 1731 (Fed. Cir. 2005). Contrary to Examiner's assertions, the present application makes clear that the Inventors possessed the invention embodied in e.g., Claims 31 and 47.

Indeed at the very outset of the application, the inventors made it quite clear that the purpose of the invention was compositions that do not contain waxes and have a particularly high solids content (paragraph numbers reference the U.S. publication):

[0001] The present invention relates to a non rinsed cosmetic keratin fibre care or makeup composition which does not contain waxes.

[0020] The compositions according to the invention, surprisingly, although containing no wax, exhibit a high solids content, specifically of more than 45% by weight, which the non rinsed compositions of the prior art have never been able to obtain without incorporating waxes.

[0030] Furthermore, the composition according to the invention is stable, even over a long period of time, and homogeneous. The dry solids extract is advantageously more than 46% by weight, preferably more than 47% by weight, more preferably more than 48% by weight and better still more than 50% by weight. In particular the dry extract of the composition is less than 85% by weight, preferably less than 75% and better still less than 65%.

[0034] It is completely surprising that the use of the specific structuring agent according to the invention, instead of the waxes used in the prior art, does not cause any increase in consistency and therefore makes it possible to attain overall solids contents which are much higher than in the prior art.

As to the structuring agent, Applicants note at least the following paragraphs:

[0036] The total fatty phase of the composition may represent from 10 to 60%, preferably from 15 to 50%, more preferably from 20 to 40% of the total weight of the

composition.

[0037] The incorporation of a specific structuring agent of this kind in part or in whole into the fatty phase is possible without greatly increasing the consistency index and it is therefore possible, by virtue of these specific structuring agents, to attain solids contents of more than 45%--much higher than in the prior art, without employing waxes.

[0038] The incorporation of this specific structuring agent into the fatty phase of the composition makes it possible, surprisingly, to obtain a high solids content in advantageous combination with a satisfactory consistency and hence to obtain the combination of easy and homogeneous application with a satisfactory thickening and separating effect.

[0039] In other words it has been possible according to the invention, without having recourse to waxes, to obtain compositions which are stable and homogeneous with a dry solids extract of more than 45% by using a specific structuring agent. Advantageously it has been possible, moreover, surprisingly to retain a consistency index of less than 1 000 Pa.

[0040] The said structuring agent is defined by specific properties of tack and of hardness. The said structuring agent is characterized by:

[0044] It has been found that the incorporation of such an agent into the fatty phase of the composition of the invention, the said agent being defined by specific values of certain parameters, made it possible precisely to obtain high solids contents without waxes, optionally in combination with the low consistencies desired, and so to obtain the combination of desired properties and effects.

[0045] The structuring agent or agents is (are) selected from combinations of a specific compound with at least one oil.

[0046] The presence of an oil is especially suitable for a cosmetic keratin fibre care or treatment composition, especially for eyelashes.

[0047] The specific compound may be selected from semi-crystalline polymers; fatty-phase rheological agents, such as polyamide-type polymers and hydrophobic silicas; and mixtures thereof.

[0051] The oil may be selected from volatile and non-volatile hydrocarbon and/or silicone and/or fluorinated oils and mixtures thereof. These oils may be animal, vegetable, mineral or synthetic in origin. By "hydrocarbon oil" is meant an oil containing primarily carbon and hydrogen atoms and optionally one or more

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functional groups selected from hydroxyl, ester, ether and carboxyl functional groups. Possible examples of oils which can be used in the invention include:

Applicants do not understand how one of skill in this field would not recognize that the primary purpose of the compositions was to provide a wax-free composition with high solids content and a structuring agent composed of a compound and an oil when that's what is repeatedly discussed and exemplified in the specification. LizardTech, Inc., supra

In the alternative, even if the exact words in the claims are not found in the specification in the same fashion or orientation, such is not required to meet the written description requirements under 112, first paragraph.

The Board of Patent Appeals and Interferences (BPAI) overturned a rejection made under 35 U.S.C. § 112, first paragraph where the Examiner rejected claims on the grounds that the claim expressions did not appear in the original disclosure (In re Sorenson 3 USPQ2d 1462 (BPAI 1987)). In Sorenson, the terms "binuclear copper complexes of carboxylic acids", "binuclear copper complex of an aliphatic carboxylic acid" and "a binuclear copper complex of an arylcarboxylic acid" were held not to violate 35 U.S.C. § 112, first paragraph in view of the fact that the specification contained four examples of binuclear copper complexes of carboxylic acids and one example of a binuclear copper complex of an aliphatic carboxylic acid. "Given those working examples together with a broader disclosure of copper complexes of carboxylic acids, both aliphatic and aromatic, we have no doubt that the Applicants' disclosure *reasonably conveys to the skilled artisan that Appellant had possession of the subject matter now claimed.*" Id. at 1464 (italics added). In dicta the BPAI stated "we are mindful that Appellants' specification need not describe the claimed invention in *ipsis verbis* to comply with a written description requirement" Id. at 1463, and "the test is whether

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the originally filed specification disclosure *reasonably* conveys to a person having ordinary skill that Applicant had possession of the subject matter later claimed." Id. at 1464 citing to In re Kaslow 217 U.S.P.Q. 1089 (CAFC 1983).

The decision in Sorenson is relevant to the rejection raised by the Examiner. The present disclosure makes it abundantly clear what the compositions are and the core features of those compositions as defined in the claims. Thus, the claims were described in the original specification in such a way as to reasonably convey to one of ordinary skill in the art that the Inventors had possession of the claimed invention.

Reconsideration and withdrawal of the rejection is requested.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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